

### **REMARKS**

Claims 1-18 are now pending in the application. By this paper, claims 1, 3, 6-7, 9, 12-13, 15, and 18 have been amended. Minor amendments have been made to the specification and claims to simply overcome the objections to the specification and rejections of the claims under 35 U.S.C. § 112. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### **SPECIFICATION**

The specification stands objected to for certain informalities. Applicant has amended the specification to address the objection. Therefore, reconsideration and withdrawal of this objection are respectfully requested.

### **REJECTION UNDER 35 U.S.C. § 102**

Claims 1-18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hatano (U.S. Pub. No. 2002/0002645). This rejection is respectfully traversed.

Applicant has amended claims 1, 3, 6-7, 9, 12-13, 15, and 18 to correct some typographical errors. Of note, in the Preliminary Amendment dated September 21, 2006, the term “ATA/IDE” in claim 18 was inadvertently changed to “ATA/DDE” and the change was not shown by markup. In this response, Applicant has amended claim 18 to correct this typographical error.

Applicant submits that paragraphs 8 and 9 of Hatano, as relied on by the Examiner, at best appear to relate to elements of the conversion device 10. In

particular, the Examiner relies on Hatano for the following elements of the conversion device 10:

the 1394 I/F unit 9 in Hatano as analogous to the element of "terminals for connection to the external databus" of claims 1, and hence implicitly the IEEE cable 20 in Hatano as analogous to the element of the "external databus" of claims 1;

the device controller 2 in Hatano as analogous to the elements of the "at least one integrated circuit chip" and the "interface" of claim 1;

the IDE port 3 in Hatano as analogous to the element of the "command bus" of claims 1 and the element of the "command bus interface" of claim 1; and

the HDD device 6 of Hatano as analogous to the element of the "storage medium device" of claim 1.

Applicant notes that the conversion device 10 on which the Examiner relies appears to be on the same side of the external databus as the storage medium device. For brevity in this Response, Applicant will refer to this as the "downstream" side of the external databus and Applicant will refer to the side of the external databus on which the host apparatus (PC 30 in Hatano) is located as the "upstream" side.

Claim 1 recites

providing the host apparatus with at least one integrated circuit chip ... having an interface arranged to convert commands received from the command bus in a format in accordance with said one of the ATA/IDE standard and the Serial ATA standard into a format in accordance with said one of the IEEE 1394 standard and the Universal Serial Bus standard and to transmit the converted commands over the external databus.

Applicant submits that one of ordinary skill in the art would appreciate that the claimed interface is provided on the upstream side of the external databus.

The ATA/IDE standard and the Serial ATA standard explicitly require commands are transmitted only from the host apparatus to the storage medium device. Of course, the technical reason is clear, namely that the host apparatus controls the storage medium device and not vice versa.

Claim 1 calls for "convert[ing] commands received from the command bus...." In contrast, Hatano at best appears to show that the controller 2 issues commands to the IDE port 3, allegedly analogous to the claimed command bus as asserted by the Examiner. Hatano, however, does not appear to disclose that controller 2 receives a command from the IDE port 3 and further converts the command received.

In paragraphs [0042] to [0050] there are various discussions relating to the handling of commands, including the storage of ATA commands in a register in the device controller 2 mentioned in paragraph [0043] and the handling of specific commands mentioned in paragraphs [0045], [0047], [0049] and [0050]. Hatano at best appears to show that a command being supplied to the storage device, i.e., in the downstream direction. Hatano does not appear to show a command being supplied from the storage device, i.e., in the upstream direction.

In Hatano, the conversion device 10 on which the Examiner relies as analogous to the "interface" of each of claims 1 does not appear to disclose the recited features of being arranged "to convert[] commands" and of being arranged "to transmit the converted commands" in the direction required explicitly by the definition of the interface in claims 1, i.e., from the command bus to the external databus. In Hatano, as the conversion device 10 is located on the downstream side of the external databus,

conversion of commands occurs only in the opposite direction from that required by the definition of the interface in claim 1, i.e., from the external databus to the command bus.

In addition, claim 1 is directed to an integrated circuit chip on the upstream side of the external databus. In contrast, the conversion device 10 in Hatano is provided on the downstream side of the external databus.

Firstly, claim 1 recites that the host apparatus, which transmits commands over the external databus, is provided with the integrated circuit chip having the interface. Secondly, claim 1 recites that the integrated circuit chip is connected to the command bus, which has previously been defined as being provided in the host apparatus.

In contrast, in Hatano the conversion device 10 on which the Examiner relies appears to be on the downstream side of the IEEE 1394 cable 20, allegedly analogous to the "external databus" of claim 1. In Hatano, even if the PC 30 can be considered as analogous to the element of the "host apparatus" of claim 1 and the HDD drive 6 can be considered as analogous to the "storage medium device" of claim 1, the PC 30 does not appear to include the other elements of the "host apparatus" as recited by claim 1.

In view of the foregoing, Applicant submits that claim 1 and its dependent claims 2-6 define over the art cited by the Examiner. Claims 7 and 13 similarly recite one or more of the distinguishing features of claim 1. Thus, Applicant submits that claim 7 and its dependent claims 8-12 as well as claim 13 and its dependent claims 14-18 define over the art cited by the Examiner for one or more of the reasons set forth above regarding claim 1.

## **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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